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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,707	12/15/2005	George Marmaropoulos	US030209US	6795
24737 7590 10/08/2009 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
PIZZALI, ANDREW T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
10/08/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/560,707

## Applicant(s)

MARMAROPOULOS ET AL.

## Examiner

Andrew T. Piziali

## Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 21-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/7/2009 has been entered.

### ***Specification***

2. The amendment filed 7/7/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The original specification is silent regarding a user appreciating what response may result from interaction with the interface. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 and 21-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Regarding claim 1, the specification is silent regarding a “user interfacier.”

Regarding claim 1, the specification is silent regarding the actuator being separate from the conductive elastomeric material. It is noted that although Figure 1 appears to illustrate the actuator (30) being separate from the conductive elastomeric material (20) on the top surface of the interface (10), the Figure fails to show the relationship between the components below the top surface.

Regarding claim 1, the specification is silent regarding a user interaction with an actuator being translated to an elastomeric material to produce a signal (said signal converted from an interaction with the conductive elastomeric material). Rather, the specification teaches that elastomeric material converts mechanical interaction or motion into a signal via the properties or characteristics of the elastomeric material (page 4, lines 2-6).

Regarding claim 6, the specification is silent regarding the actuator being formed from a material that is more rigid than the conductive elastomeric material.

Regarding claim 8, the specification is silent regarding an actuator depicting a response.

Regarding claim 24, the specification is silent regarding an actuator being “separate” (see claim 1) from a conductive elastomeric material while also being “in contact” (claim 24) with said conductive elastomeric material.

5. Claims 1-9 and 21-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, the specification does not enable one skilled in the art to form an actuator that is cooperative with a conductive elastomeric material to provide a user interfacier such that a user interaction with the actuator is translated to said conductive elastomeric material to produce a signal converted from an interaction with the conductive elastomeric material. The specification does not disclose how a plastic or rubber actuator can be constructed to be cooperative as claimed.

Regarding claim 2, the specification does not enable one skilled in the art to make or use the textile of claim 1 wherein one or more characteristics of the conductive elastomeric material change in response to an interaction.

Regarding claim 8, the specification does not enable one skilled in the art to make or use an actuator that depicts a response to interaction with a user interface.

Regarding claim 9, the specification does not enable one skilled in the art to make or use the textile of claim 1 wherein one or more characteristics of the conductive elastomeric material change in proportional response to an interaction wherein said interaction causes one or more areas of the conductive elastomeric material to be displaced.

Regarding claim 21, the specification does not enable one skilled in the art to make or use an actuator that cooperates with one or more conductive areas.

Regarding claim 22, the specification does not enable one skilled in the art to make or use one or more conductive areas wherein one or more characteristics change in response to an interaction with an actuator.

Regarding claim 23, the specification does not enable one skilled in the art to use said displacement ratio as claimed.

Regarding claim 24, the specification does not enable one skilled in the art to cause one or more areas of the conductive elastomeric material to be displaced by the conductive elastomeric material interaction in addition to the actuator interaction.

Regarding claims 25-27, the specification does not enable one skilled in the art to make or use the interface to be operable as claimed.

Regarding claim 28, the specification does not enable one skilled in the art to make or use a conductive fiber having a conductive threadlike core.

Regarding claims 29-31, the specification does not enable one skilled in the art to make or use a conductive fiber with a conductive semi-fluid sleeve.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-9 and 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase “user interfacier” renders the claims indefinite. It is not clear what constitutes a “user interfacier.”

Regarding claim 1, it is not clear how the actuator can be both separate (claim 1) and in contact (claim 24) with the conductive elastomeric material.

Regarding claim 1, it is not clear how a user interaction can be “translated” to a conductive elastomeric material.

Regarding claim 1, it is not clear how a user interaction with the actuator can be translated to a conductive elastomeric material to produce a signal wherein the signal itself is converted by interaction with the conductive elastomeric material. It is not clear if the user interacts with the actuator, the conductive elastomeric material, or both.

Regarding claim 1, the use of the phrase “an actuator cooperative with said conductive elastomeric material to provide a user interfacier” renders the claim indefinite. The claim is amenable to two plausible definitions. Based on the description provided in the specification, “cooperative” could be interpreted to mean: (a) work together or (b) compliant. Thus, neither the specification, nor the claims, nor the ordinary meanings of the words provides any guidance as to what applicant intends to cover with this claim language. Due to the ambiguity as to what is intended by the claimed limitation and the fact that this claim element is amenable to two or more plausible claim constructions, this claim is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicant considers to be the invention. See *Ex parte Miyazaki* (BPAI Precedential 19 November 2008).

Regarding claims 29-31, the phrase “semi-fluid sleeve” renders the claims indefinite. It is not clear what materials are considered semi-fluid, thereby rendering the scope of the claims unascertainable.

*Claim Rejections - 35 USC § 102/103*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9 and 21-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 6,360,615 to Smela.

Smela discloses a textile construction comprising: a conductive elastomeric material suitable for converting an interaction therewith into a signal; and an actuator cooperative with said conductive elastomeric material to provide a user interface, wherein said actuator is separate from said conductive elastomeric material and is configured for user interaction to produce said signal and wherein said actuator is formed from one or more of plastic and rubber (see entire document including the Figures, column 4, lines 18-34, column 7, lines 8-67, and the paragraph bridging columns 11 and 12).

In the event that it is shown that the applied prior art does not disclose the claimed embodiment with sufficient specificity, the invention is obvious because the prior art specifically discloses the claimed constituents.



Regarding claim 2, one or more characteristics (e.g., resistance) of the conductive elastomeric material changes in response to the interaction (column 7, lines 8-13).

Regarding claim 3, the conductive elastomeric material has piezoelectric characteristics (column 7, lines 59-67).

Regarding claim 4, the conductive elastomeric material comprises any of the claimed conjugated polymers or ion-implanted polymer (column 7, line 59 through column 8, line 3).

Regarding claim 5, the conductive elastomeric material can have one or more of the claimed elements (column 8, lines 4-6).

Regarding claims 6 and 7, Smela discloses that plastic housings may be used (paragraph bridging columns 11 and 12). Therefore, it appears that Smela discloses that the actuator may be formed from plastic. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the actuator from any suitable material, such as plastic or rubber, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Regarding claim 8, the actuator is cooperative with the conductive elastomeric material (column 7, lines 8-13).

Regarding claim 9, one or more characteristics of said conductive elastomeric material changes in proportional response to said interaction, said interaction causing one or more areas of said conductive elastomeric material to be displaced (column 9, lines 3-8).

Regarding claims 21, the actuator is cooperative with one or more conductive areas (column 4, lines 18-34).

Regarding claim 22, one or more characteristics of said one or more conductive areas change in response to an interaction with said actuator (column 7, lines 8-13).

Regarding claim 23, the intended use recitation of the claimed invention does not result in a structural difference between the claimed invention and the prior art.

Regarding claim 24, the interaction causes one or more areas of said conductive elastomeric material to be displaced without requiring a lateral displacement of said actuator (column 4, lines 18-34).

Regarding claims 25-27, considering that the textile construction disclosed by the applied prior art is substantially identical to the claimed textile construction, the user interface is inherently operable as claimed.

11. Claims 1-3, 5-9 and 21-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPAP 2002/0075232 to Daum.

Daum discloses a textile construction comprising: a conductive elastomeric material suitable for converting an interaction therewith into a signal; and an actuator cooperative with said conductive elastomeric material to provide a user interface, wherein said actuator is separate from said conductive elastomeric material and is configured for user interaction to produce said signal and wherein said actuator is formed from one or more of plastic and rubber (see entire document including the Figures, [0009], [0033], [0035], [0038], [0039], [0047]).

In the event that it is shown that the applied prior art does not disclose the claimed embodiment with sufficient specificity, the invention is obvious because the prior art specifically discloses the claimed constituents.

Regarding claim 2, one or more characteristics (e.g., resistance) of the conductive elastomeric material changes in response to the interaction ([0037] and [0038]).

Regarding claim 3, the conductive elastomeric material has piezoelectric characteristics ([0037] and [0038]).

Regarding claim 5, the conductive elastomeric material can have one or more of the claimed elements (Figures and [0039]).

Regarding claims 6 and 7, one of the rubber layers of the textile construction may be considered an actuator [0038].

Regarding claim 8, the actuator is cooperative with the conductive elastomeric material ([0038] and [0039]).

Regarding claim 9, one or more characteristics of said conductive elastomeric material changes in proportional response to said interaction, said interaction causing one or more areas of said conductive elastomeric material to be displaced ([0038], [0039], and [0047]).

Regarding claims 21, the actuator is cooperative with one or more conductive areas ([0047]).

Regarding claim 22, one or more characteristics of said one or more conductive areas change in response to an interaction with said actuator ([0038] and [0047]).

Regarding claim 23, the intended use recitation of the claimed invention does not result in a structural difference between the claimed invention and the prior art.

Regarding claim 24, the interaction causes one or more areas of said conductive elastomeric material to be displaced without requiring a lateral displacement of said actuator ([0038] and [0047]).

Regarding claims 25-27, considering that the textile construction disclosed by the applied prior art is substantially identical to the claimed textile construction, the user interface is inherently operable as claimed.

Regarding claims 27-31, Daum discloses that the conductive elastomeric material is formed from conductive fibers having a conductive core ([0039]).

***Claim Rejections - 35 USC § 103***

12. Claims 1-9 and 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPAP 2001/0017759 to Marmaropoulos in view of USPN 6,360,615 to Smela.

Marmaropoulos discloses a textile construction comprising: a conductive elastomeric material suitable for converting an interaction therewith into a signal; and an actuator cooperative with said conductive elastomeric material to provide a user interface, wherein said actuator is separate from said conductive elastomeric material and is configured for user interaction to produce said signal and wherein said actuator is formed from one or more of plastic and rubber (see entire document including the Figures, [0015], [0016], [0017], [0022], and [0023]).

Marmaropoulos is silent with regards to specific actuator materials, therefore, it would have been necessary and thus obvious to look to the prior art for conventional materials. Smela discloses that it is known in the art to use plastic housings (paragraph bridging columns 11 and 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the actuator from plastic, motivated by the expectation of successfully practicing the invention of Marmaropoulos.

Regarding claim 2, one or more characteristics (e.g., resistance) of the conductive elastomeric material changes in response to the interaction [0017].

Regarding claim 3, the conductive elastomeric material has piezoelectric characteristics [0017]. In addition, Smela discloses that it is known in the art to use piezoelectric materials such as that claimed (see entire document including column 7, line 59 through column 8, line 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cord from any suitable conductive elastomeric material, such as that currently claimed, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Regarding claim 5, the conductive elastomeric material can have one or more of the claimed elements [0015].

Regarding claims 6 and 7, In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the actuator from any suitable material, such as plastic or rubber, because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

Regarding claim 8, the actuator is cooperative with the conductive elastomeric material [0015].

Regarding claim 9, one or more characteristics of said conductive elastomeric material changes in proportional response to said interaction, said interaction causing one or more areas of said conductive elastomeric material to be displaced [0016].

Regarding claims 21, the actuator is cooperative with one or more conductive areas ([0023]).

Regarding claim 22, one or more characteristics of said one or more conductive areas change in response to an interaction with said actuator ([0016]).

Regarding claim 23, the intended use recitation of the claimed invention does not result in a structural difference between the claimed invention and the prior art.

Regarding claim 24, the interaction causes one or more areas of said conductive elastomeric material to be displaced without requiring a lateral displacement of said actuator ([0016 and [0023]).

Regarding claims 25-27, considering that the textile construction disclosed by the applied prior art is substantially identical to the claimed textile construction, the user interface is inherently operable as claimed.

13. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,360,615 to Smela as applied to claims 1-9 and 21-27 above, and further in view of USPN 5,346,649 to Karna.

Smela discloses the use of electrically conductive coated plastic fibers (column 7, lines 33-58), but Smela does not appear to specifically teach the claimed core conductive fiber material. Karna discloses that intrinsically electrically conducting plastic material is known (see entire document including column 1, lines 6-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the conductive fibers from any suitable material, such as that disclosed by Karna, because the fibers are lightweight, possess advantages mechanical properties, possess good corrosion resistance, and/or because the fibers

are low cost (column 1, lines 17-27), and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

14. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPAP 2001/0017759 to Marmaropoulos in view of USPN 6,360,615 to Smela as applied to claims 1-9 and 21-27 above, and further in view of USPN 5,346,649 to Karna.

Marmaropoulos discloses the use of electrically conductive coated plastic fibers ([0016]), but Marmaropoulos does not appear to specifically teach the claimed core conductive fiber material. Karna discloses that intrinsically electrically conducting plastic material is known (see entire document including column 1, lines 6-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the conductive fibers from any suitable material, such as that disclosed by Karna, because the fibers are lightweight, possess advantages mechanical properties, possess good corrosion resistance, and/or because the fibers are low cost (column 1, lines 17-27), and because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability and desired characteristics.

#### ***Response to Arguments***

15. Applicant's arguments filed 7/7/2009 have been fully considered but they are not persuasive.

Regarding claim 6, the applicant asserts that since the specification discloses specific elastomeric non-conductive fiber materials and specific actuator materials, the specification

provides written description for the actuator material being more rigid than the conductive elastomeric material. The examiner respectfully disagrees. The specification does not disclose that the actuator material is more rigid than the conductive elastomeric material. Firstly, the claim refers to the (overall) conductive elastomeric material while applicant's argument refers to non-conductive elastomeric material. Therefore, applicant's arguments are not commensurate in scope with the current claim. Secondly, the disclosure fails to describe any of the actuator materials as necessarily more rigid than any of the elastomeric materials.

The applicant asserts that Smela, Daum, and Marmaropoulos each fail to teach or suggest that the actuator is cooperative with the conductive elastomeric material such that a user interaction with the actuator is translated to the conductive elastomeric material to produce the signal. The examiner respectfully disagrees. Firstly, the claims are rejected under both 35 USC 112 first and second paragraph. Secondly, the actuators are compliant with the conductive elastomeric material. Thirdly, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The applicant asserts that Marmaropoulos fails to teach or suggest that the actuator is formed from plastic or rubber. In response to applicant's arguments against one reference individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).



***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on (571) 272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew T Piziali/  
Primary Examiner, Art Unit 1794